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EXAMINER

RUDY, ANDREW J

ART UNIT	PAPER NUMBER
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3627

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/474,576
Filing Date: December 29, 1999
Appellant(s): MOLLETT ET AL.

MAILED

DEC 17 2003

GROUP 3600

Mark D. Chuey, Ph.D.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 22, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The statement of the status of the claims contained in the brief is correct.

(3) *Status of Claims*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because from page 3, lines 10-12, Figure 1 does not properly disclose the scope of Applicant's inventive concept as claimed. In particular, claims 9-13 do not recite any microprocessor as illustrated in Figure 1.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 9-13 and 14-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3627

(9) Prior Art of Record

5,679,940

TEMPLETON ET AL.

10-1997

(10) Grounds of Rejection

Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al, US 5,679,940.

(11) Response to Argument

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, the claim language does not preclude everything from being done in ones head. The storing, classifying, modifying, labeling, receiving, processing, removing and retaining reiterated in the claims do not preclude each from being done in ones mind alone or in combination with pen and pencil.

Further, no technological art is presently claimed.

Appellant's ARGUMENT has been reviewed, but are not convincing. The processing of the checks as recited in claims 9-13 need not contain any technology as presently claimed. See, Ex Parte Bowman, 61 USPQ2d 1165, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished). Though Bowman is not precedent, its value is cited for its analysis. Also, see MPEP 2106 IV 2(b). Contrast this claim 14, line 5, where a "processor" is positively recited. Thus, the recitation of claims 14-16 is deemed proper for examination purposes.

Appellant's assertion from page 5, line 6, that "Appellant's invention deals with processing checks" is not agreed with. Claims 9-13 do not recite this claim language. Claims 9 recites "the collectability of check writers" while from claim 12 "the collectability of a check writer" is claimed. No processing check claim language is present in these claims.

The recent Supreme Court decision citations are noted. It is noted no claimed algorithm is recited in the claims. However, even though the present application is neither a law of nature nor a natural phenomenon, the claims in question do not rise to the level of patentable subject matter. Reiterating, Appellant's claim language, may be executed in ones mind and/or with pen and pencil. From claim 9, line 6, the "modifying the negative file" falls under this reasoning. For example, the negative information may simply be erased with a pencil eraser and the data on a piece of paper would be modified.

The Examiner does not agree with Appellant's assertion that a modified database is positively recited from claim 12. However, even if from claim 12, line 7, "removing the negative information from the database" were to imply a modified database, the pen/paper analogy still is not overcome. As is, the claims in question are abstract in nature and don't produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al, US 5,679,940.

Templeton discloses, e.g. Fig. 1, a method using a computer for determining whether to collect from check writers from data comprising a negative file 85, a positive file 87 and a credit risk scoring algorithm 90, e.g. cols. 12-14. Templeton discloses packets, e.g. col. 6, of information sent that helps label a check writer into a designated category. Templeton does not specifically indicate the negative file 85 is modified by removing the negative information, but does indicate that the negative file 85 is "continuously updated" (col. 12, line 59) and that the positive file 87 is used (col. 13, lines 18-34) to determine suitability of cashing a check. Templeton inherently contains categories to ascertain whether a check will be honored or not. Templeton updates his files, e.g. (e.g. col. 5, lines 20-45). It is common knowledge and well known in the art that negative information, e.g. honest mistakes of an individual and/or banking institution, are removed from ones credit reports when assessing whether or not to cash a check.

It appears entirely logical and inherent that if a file is continuously updated, that some data is either added or removed to the Templeton database. Thus, one may reasonably infer that either positive or negative information is updated or both events occur during the continuous updating executed by Templeton. Thus, even though not directly addressed by Templeton, to have provided a modification of a negative file by removing negative information for Templeton would have been obvious to one of ordinary skill in the art. Doing such would use well known correction factors to provide a more complete and updated database for risk assessment, e.g. credit scoring. To have provided the negative file to comprise a scrubbed file would have been obvious to one of ordinary skill in the art as scrubbed files are well known in the art.

Appellant's ARGUMENT with regard to claims 9 and 12 has been reviewed, but are not convincing. It is noted that claim 12 does not provide for plural check writers, but only a single check writer (see claim 12, line 1). Appellant's remarks from page 8, paragraph 3, line 3, that this information is not relevant is not convincing, as the information is deemed relevant. It is the Examiner's position that the negative information disclosed by Templeton is relevant information that comprises a negative file that is modified. Whether or not the activity is done in real-time is not at issue. The claim language makes no such distinction.

Appellant's statement from page 9, line 3, of the Brief is noted. The Examiner notes that "anyone" is a sweeping statement and the Examiner does not concur with its conclusion. Presently, as claimed, presenting, via a telephone call, letter or in person, a check to bank teller or grocer, and having the bank teller or grocer cash the check after being alerted to an inadvertent error would read upon Applicant's claims 9-13.

Appellant's statement regarding claims 14-16, from page 9 of the Brief is noted.

However, the claim language does not positively recite, "a processor classifies individual check writers into one of a plurality of predetermined categories" as noted by Appellant. Appellant's claim 14, lines 5-6, claims "the processor operative to" which is not consistent with Appellant's arguments. As is, the processor of Templeton "relates to", i.e. is operative, the classification of check writers. No lexicography definition has been presented by Appellant to deviate from the plain meaning of the word operative. Thus, Templeton's system is "operative" and fully encompasses in broad scope and content Appellant's claim language.

Thus, claims 9-16 should not be allowed.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 3627

Respectfully submitted,




Andrew Joseph Rudy
Examiner, Art Unit 3627
December 13, 2003


Conferees

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